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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/548,401	09/26/2005	Hiroshi Morisaki	05126	7990
23338 7590 03/16/2010 DENNISON, SCHULTZ & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314				
EXAMINER				
NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/548,401

Applicant(s)

MORISAKI ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 1, 2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 4 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “wherein the cutting line is provided on a portion of one end periphery of the tape body so that the positioning tab is previously separated from the tape body other than the cutting line” in claim 1, is unclear, which renders the claim vague and indefinite. It is unclear if this limitation is supposed to be a method of use or a structural limitation. It is also unclear how the positioning tab is supposed to be previously separated from the tab by other than cutting line when the cutting line is supposed to cause the separation of tab from the tape body.

Claims 4 – 8 is also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication No. 2-353 U in view of Barbieri (USPN 4,004,362).

JP 2-353 U discloses an adhesive tape (Figures 1 – 4), comprising: a tape body to be adhered to an adherend (Figures 1 and 2, #24), a positioning tab positioned on one end periphery of the tape body (Figures 1 and 3, #26), and a release sheet provided on a rear side of the tape body (Figure 1, #28), wherein the positioning tab and the tape body are interconnected via a connecting portion that is positioned there between, the connecting portion (Figures 4, #26) and further including a cutting line penetrating through the tape body (Figure 2, #27) and the release sheet (Figure 3, the line separating #28A and 28B), wherein the cutting line is provided on a portion of one end periphery of the tape body so that the positioning tab is previously separated from the tape body other than the cutting line (Figure 4; Figure 3, #27) as in claim 1. With regard to claim 2, the positioning tab is positioned along one end periphery (Figures 4, #26), and wherein the connecting portion is partly provided on one end periphery so that the tab is

separated from the tape body other than the connecting portion (Figures 4, #26). As in claim 3, the release sheet is provided on the entire area of the rear side of the tape body (Figure 1, #28), and wherein the release sheet has a slit that is formed adjacent to the connecting portion (Figure 3, #28A and 28B). Regarding claim 4, the release sheet has an additional slit that is formed in a side periphery thereof (Figure 3, #28A and 28B). With regard to claim 5, the release sheet extends onto a rear side of the positioning tab beyond the connecting portion (Figure 1, #28). As in claim 6, the positioning tab has a fixing element that is positioned adjacent to the connecting portion (Figure 4, #26). Regarding claim 7, the tape body comprises an elongated tape body (Figure 3, #24), wherein the one end periphery of the tape body corresponds to one of longitudinally opposed end peripheries of the tape body, and wherein the slit is formed so as to extend along one of the laterally opposed end peripheries of the tape body (Figure 3, #28A and 28B). With regard to claim 8, the adhesive tape is designed to be applied to a vertical frame of a vehicle door, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. However, JP 2-353 U fails to disclose a cutting line penetrating through the tape body and the release sheet in the same location and wherein the cutting line is arranged and constructed to be ruptured therealong, so that the positioning tab can be separated from the tape body along the cutting line.

Barbieri teaches a tape body to be adhered to an adherend (Figures 1 and 8, #11), and a release sheet provided on a rear side of the tape body (Figures 1 and 2, #13), wherein a cutting line penetrating through the tape body and the release sheet in the same location (Figure 1, #16;

Figure 8, #28; Column 2, lines 42 – 44) for the purpose of protecting the adhesive while controlling the removal of the backing layer (Column 2, lines 60 – 65).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cutting line penetrating through the tape body and the release sheet in the same location in JP 2-353 U in order to protect the adhesive while controlling the removal of the backing layer as taught by Barbieri.

With regard to the limitation of “wherein the cutting line is arranged and constructed to be ruptured therealong, so that the positioning tab can be separated from the tape body along the cutting line” in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since Barbieri teaches that the cutting line penetrating through the tape body and the release sheet in the same location (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) is a perforated line, it is capable of being ruptured and separated.

Response to Arguments

6. Applicant's arguments filed February 1, 2010 have been fully considered but they are not persuasive.

In response to Applicant's argument that the newly added specific recitations are patentably distinguishable over the prior art, please see the 112 2nd rejection and 103 rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794